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7590 02/25/2004  
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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT PAPER NUMBER

3623

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

***Notice of Non-Responsive Reply***

1. The reply filed on December 15, 2003 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): Applicant elects Species I, Subspecies A<sub>3</sub>, Subspecies B<sub>1</sub>, and Subspecies C<sub>1</sub> and submits that claims 1-34, 36-146, 148-248, 250-272, 274-320, and 429-505 are directed toward the elected species and subspecies. The Examiner has studied the elected claims and finds that the elected claims are replete with examples of claims that incorporate subject matter from non-elected species. Furthermore, many of the claims improperly combine mutually exclusive species. For example, claim 32 recites that "a condition determinative of said periodic delivery of said personal information is selected from the group consisting of a user's request for specific information, a user-defined schedule, and a specific event chosen by a user." This subject matter spans Subspecies A<sub>1</sub> through A<sub>3</sub> of Species I (i.e., two of which are non-elected species). Similarly, the subject matter presented in claim 59 spans Subspecies B<sub>1</sub> and B<sub>2</sub>. Also, Applicant asserts that both claims 107 and 207 are directed toward the elected Species I. However, claim 107 is directed toward delivering personalized information to an individual user (Species I) while claim 207 (which is dependent from claim 107) is directed toward delivering personalized information to a group of users (Species II) and assessing the evolution of group interests by analyzing the total number of trajectories for all subscribers of personalized information or members of any group (Subspecies A<sub>2</sub>). Again, claim 207 integrates subject matter that is mutually exclusive from the subject matter introduced in independent claim 107. These types of inconsistencies are replete throughout the

claims. Applicant has failed to elect claims that truly read on the elected species and subspecies. Furthermore, since many of the claims improperly combine subject matter from various species and subspecies that are identified as mutually exclusive, Applicant is expected to amend the claims accordingly so that they are limited to the elected species and subspecies.

See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

2. Applicant argues that the restriction is improper because the species are directed toward disclosed instead of claimed species (page 2 of Applicant's election). Applicant has elected at least one species that is reflected in the pending claims, as shown by the fact that Applicant was able to elect at least one claim. Even if, as Applicant asserts, there are some subspecies that do not read on any claims, such an argument does not affect the validity of the restriction. Applicant has the option of adding claims that are directed toward any of the elected species and subspecies. Furthermore, Applicant states that the species and subspecies "mostly fall within the generic independent claims" (page 2 of Applicant's election); however, Applicant cites no support from the specification for such an assertion. For example, the specification does not provide any explicit description of how Species I and Species II are integrated into one contiguous

embodiment. The same is true of each set of subspecies. The Examiner maintains that each set of species and subspecies is described in the specification as mutually exclusive.

Additionally, should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. Applicant has not done so yet.

Applicant argues that the restriction is improper under MPEP § 832.02 because the subspecies require restriction of Markush groups. MPEP § 832.02 states:

...A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. § 103 with respect to the other member(s).

In the present case, the Markush claims include diverse members that are not obvious variants of each other. For example, Markush claim 32 recites that “a condition determinative of said periodic delivery of said personal information is selected from the group consisting of a user’s request for specific information, a user-defined schedule, and a specific event chosen by a user.” Clearly, different (and mutually exclusive) methodology is required for delivering information based on a user’s request for specific information (on-demand) versus a user defining a schedule to receive information in the future versus establishing a specific event that triggers transmission of collected

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information. The specification describes these options as three different embodiments for delivery options:

...In one embodiment, the user should first contact the server indicating his individual password or identifier. One of the available delivery options should be selected by the user as part of the system's setup. The simplest of them is delivery at the user's direct request sent to the publisher's or distributor's server. Another basic option is delivery of current issues according to a user-defined schedule. More complicated options require to specify an event upon the occurrence of which a new issue should be delivered to the user. An example of such an event is the accumulation of a user-defined amount of unpublished information materials that should be enough to generate a new issue... (Page 10, line 19 through Page 11, line 4 of the specification)

The fact that a user selects only one delivery option implies that each delivery option is mutually exclusive of the other. The specification never states that all of these delivery options may be used in concert with one another, i.e., each option embodies a different species.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

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Any response to this action should be mailed to:

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or faxed to:

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7<sup>th</sup> floor receptionist.



Susanna M. Diaz  
Primary Examiner  
Art Unit 3623  
February 23, 2004